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21 UNITED STATES DISTRICT COURT
22 NORTHERN DISTRICT OF CALIFORNIA
23 SAN FRANCISCO DIVISION

24 ORACLE AMERICA, INC.
25 Plaintiff,
v.
26 GOOGLE INC.
27 Defendant.

Case No. CV 10-03561 WHA
**ORACLE'S OPPOSITION TO GOOGLE'S
MOTION IN LIMINE NO. 5 RE
LINDHOLM EMAIL**
Dept.: Courtroom 8, 19th Floor
Judge: Honorable William Alsup

INTRODUCTION

2 Google’s MIL No. 5 Re Lindholm Email does not seek to exclude Google Engineer
3 Timothy Lindholm’s August 6, 2010 email (TX 10). Rather, Google seeks permission to offer an
4 Oracle presentation and other undisclosed “evidence” of pre-lawsuit settlement negotiations
5 between the parties to argue that the email pertains to “Oracle’s assertions of **patent—not**
6 **copyright**—infringement.” ECF 1555 (Google’s Mot.) at 1. But the parties already agreed
7 during discovery that such evidence was protected from disclosure under Federal Rule of
8 Evidence 408 and would not be admissible at trial. Relying on this agreement, Oracle voluntarily
9 withdrew from its disclosures two rebuttal witnesses with knowledge of the July 20, 2010
10 settlement negotiations, including the role played by Oracle’s copyrights. Allowing Google to
11 renege on the agreement will prejudice Oracle. In fact, when Oracle re-disclosed the rebuttal
12 witnesses based on the present motion, *Google objected to the disclosure*. Now, at the eleventh
13 hour, Google not only seeks to admit evidence it promised it wouldn’t, but it also seeks to
14 preclude admission of Oracle’s evidence that *copyrights were discussed* at the meeting.

15 Moreover, Oracle’s presentation and any other FRE 408 evidence are irrelevant because
16 Google has not shown any connection between the settlement meeting and Mr. Lindholm’s email.
17 The face of the email does not mention the meeting, patents or copyrights. It is strictly about
18 “*technical alternatives*” to the Java platform. TX 10. And Mr. Lindholm will be unable to link
19 the settlement meeting to the email because the Court has precluded Mr. Lindholm from offering
20 details about the who/what/why of his investigation. ECF 676 at 7.

21 Google’s current argument that the Lindholm email pertains to patents also contradicts its
22 position and Mr. Lindholm’s testimony in the first trial. There, Google argued and Mr. Lindholm
23 swore that the email had *nothing to do with patent infringement*. See ECF 492 (Google’s
24 Lindholm MIL) at 2. There is no evidence that Mr. Lindholm’s analysis was limited to patents
25 exclusive of copyrights.

26 I. Google Fails To Show A Connection Between The Email And The Meeting

27 Google's motion fails to establish any connection between the July 20, 2010 meeting and
28 the Lindholm email that would justify exempting the settlement negotiations from FRE 408. The

1 email says nothing on its face about the settlement meeting. TX 10. And Google gives no clue
 2 how it can possibly link the Lindholm email with the meeting without violating the Court's prior
 3 order prohibiting testimony about the details of Mr. Lindholm's investigation. ECF 676 at 7
 4 (precluding Mr. Lindholm from explaining his email because Google refused to allow Mr.
 5 Lindholm to testify during deposition about the scope and nature of his investigation); *see also*
 6 Ex. D (Lindholm Dep.) 101:15-105:10 (asserting privilege over Mr. Lindholm's testimony). The
 7 failure to establish this link to the settlement meeting, and to exclude the "reasonable possibility
 8 that the email concerned another, non-privileged matter," is the reason the email was not
 9 protected by attorney-client privilege in the first place.¹ *See* ECF 546 at 10.

10 Without this link, Google's motion seeks permission for counsel to stand up in front of the
 11 jury and argue that because the email was purportedly "on the heels of a threat from Oracle just
 12 about patent litigation," it must be limited to patents. *See* Apr. 19, 2016 Hr. Tr. 170:2-5. Not
 13 only is it untrue that Oracle's threat concerned only patents, but also the timing of the email is
 14 not, by itself, enough to establish a connection with the settlement meeting. Google's desire to
 15 encourage the jury to make this speculative leap does not justify exempting the settlement
 16 negotiations from FRE 408.

17 **II. Google Contradicts Its Prior Representations And Mr. Lindholm's Sworn Testimony**

18 Google's current claim is also inconsistent with the content of the email and Mr.
 19 Lindholm's prior testimony. Google currently contends that "Mr. Lindholm's email concerned
 20 Java-related patents" only, and had nothing to do with the general availability of technical
 21 alternatives to Java. ECF No. 1555 at 1. But the email, on its face, says otherwise. TX 10
 22 ("What we've actually been asked to do (by Larry and Sergei) is to **investigate what technical**
 23 **alternatives exist to Java** for Android and Chrome") (emphasis added) and ("We conclude that
 24 **we need to negotiate a license to Java** for Android and Chrome") (emphasis added). The email
 25 does not refer to Java-related patents.

26 By contrast, when infringement was still a live issue Google repeatedly argued, and Mr.
 27

28 ¹ The Magistrate Judge, this Court, and the Federal Circuit all rejected Google's argument that the
 email is privileged. *See* ECF Nos. 714 (Order on Pet. of Writ of Mand.) 361, 546.

1 Lindholm declared under oath, that the email had ***nothing to do with patent infringement***:

- 2 • Google: “there are declarations before this Court where Mr. Lindholm made clear
3 several times that ***he never engaged in a patent infringement analysis with respect***
4 ***to the Android platform ever with regard to any patent***. So that would be highly
 misleading ...” Tr. (C. Anderson) 2827:23-2828:2 (emphasis added).
- 5 • Google: “Again, [Mr. Lindholm] ***conducted no analysis of, and had no opinion***
6 ***about, whether the Android platform actually infringes any of the patents*** or copy-
 rights asserted by Oracle in this lawsuit.” ECF 492 at 2 (emphasis added).
- 7 • Mr. Lindholm: “When I wrote the August 6, 2010 email ... ***I had never reviewed the***
8 ***patents*** asserted by Oracle in this lawsuit,” and “***I did not, in fact, undertake to ana-***
9 ***lyze whether the Android platform infringes any of the patents ... asserted by Ora-***
 cle,” and, “Again, I conducted ***no analysis of, and had no opinion about, whether***
 the Android platform actually infringes any of the patents ...” ECF 497-1 (Lind-
 holm Decl.) at 1 (emphasis added).

11 There is no way to square Google’s present claim that Mr. Lindholm’s email dealt only with
12 alternatives to Java-related ***patents*** with Google’s and Mr. Lindholm’s past statements. These
13 repeated admissions show that Mr. Lindholm investigated alternatives to Java generally, without
14 regard to patents, as indicated in the email. *Id.* The Court should not allow Google to use FRE
15 408 evidence to mislead the jury into believing otherwise.

16 **III. The Parties Mutually Agreed To Not Admit Settlement Negotiations**

17 The parties long ago agreed that evidence regarding settlement discussions would be off
18 limits at trial. This agreement was undertaken to avoid a protracted battle over the admission of
19 such evidence at trial, and to eliminate the need to present as witnesses attorneys involved in the
20 settlement negotiations.

21 At the first trial, Google’s lawyer attempted to undermine Oracle’s copyright infringement
22 claims during his opening by arguing that Oracle did not raise them during the parties’ settlement
23 negotiations:

24 [Oracle] then claimed for the first time [in July 2010]: Google you’re wrong. We
25 want money based on Android. You’ve copied our technology. ***They didn’t even***
26 ***mention the APIs, there was no mention of APIs, none.*** They said, We have all
 these patents, and so on and so forth.

27 Tr. 275:5-10 (emphasis added). This argument was misleading and is exactly what FRE 408 for-
28 bids: “Evidence of [conduct or statements made in compromise negotiations] ... is not admissible

1 on behalf of any party, when offered to prove ... invalidity of ... a claim that was disputed as to
 2 validity ...”

3 Concerned that Google might again violate FRE 408, on August 27, 2015, Oracle
 4 disclosed witnesses who could testify at the remand trial that Oracle asserted copyright
 5 infringement claims at the July 20, 2010 meeting. Oracle also informed Google that its past
 6 argument based on settlement negotiations “is ... improper under Rule 408, [and] it is incorrect,”
 7 and that “we do not intend to call the lawyers on our list ... unless Google persists in arguing that
 8 there were no discussions of copyright at the pre-lawsuit meeting between Oracle and Google.”
 9 Ex. A (11/12/2015 Simpson Email to Kamber).² Google agreed not to introduce evidence of
 10 settlement discussions:

11 Please provide the amended disclosures [removing the witnesses] as soon as pos-
 12 sible, which will—at least for now—moot our request for depositions. But given
 13 Oracle’s withdrawal of these witness disclosures, we also expect that Oracle will
 14 not seek to introduce evidence regarding the parties’ pre-litigation meeting and
 15 what was—or wasn’t—discussed at that meeting.

16 Ex. B (11/25/2015 Kamber Email to L. Simpson).

17 Based on Google’s representations, Oracle removed from its disclosures the witnesses it
 18 had identified to rebut Google’s misleading or false characterizations of the parties’ settlement
 19 discussions. These witnesses were never deposed, and Oracle conducted no more discovery on
 20 the settlement discussions. Inducing Oracle to amend its witness disclosures and refrain from
 21 further discovery only to revive this issue on the eve of trial is pure gamesmanship. *See*
 22 *Conceptus, Inc. v. Hologic, Inc.*, No. C 09-02280 WHA, 2010 WL 3324395, at *1 (N.D. Cal.
 23 Aug. 23, 2010) (“As the end game before trial approaches, both sides have an interest in
 24 fortifying their respective claims and defenses. Thus, any last-minute changes to positions and
 25 theories ... will risk prejudicing the other side.”). Allowing Google to renege on its agreement
 26 and use FRE 408 evidence would prejudice Oracle. In light of Google’s motion seeking to use
 27 such evidence, Oracle re-disclosed on its witness list the rebuttal witnesses it had withdrawn
 28 pursuant to the parties’ agreement. In response, Google *objected* to those witnesses. Ex. C
 (4/26/2016 R. Mullen Email to R. Uriarte). Oracle thus will need to secure rebuttal witnesses for

² All Ex. ____ cites are to the Silverman Declaration submitted in support of this opposition.

1 trial and possible deposition, *all over Google's objection*, just days before trial is set to begin.³

2 **IV. Google Is Not Entitled To An Exemption From FRE 408**

3 Google does not argue that FRE 408 is inapplicable to the evidence it seeks to use. Nor
 4 does Google cite any authority allowing unilateral exemption from FRE 408 to rebut a non-
 5 privileged and admissible email, or to fill an evidentiary gap Google created by asserting
 6 privilege. Google does not even submit the evidence it seeks to admit through its motion,
 7 requiring the Court to rely on Google's assertions about the evidence. What Google proposes—
 8 use of "a party's good faith settlement offer against him"—is "exactly the concern underlying
 9 Rule 408." *Apple, Inc. v. Samsung Elecs. Co.*, No.: 12-CV-00630-LHK, 2014 WL 794328, at
 10 *8 (N.D. Cal. Feb. 25, 2014) (quotation marks omitted). "Rule 408 is premised on a strong public
 11 policy of encouraging settlements," and "[a]dmission of evidence of the settlement could work to
 12 discourage plaintiffs and defendants from settling" *Id.* at *9 (quotation marks omitted).

13 Google's accusation that *Oracle* is using the Lindholm email simultaneously as a sword
 14 and a shield (ECF No. 1555 at 2) turns the record upside down. There is no connection between
 15 the email Oracle intends to admit at trial and the FRE evidence Oracle seeks to protect. Rather, it
 16 was Google who asserted the attorney-client privilege to shield Mr. Lindholm's investigation.
 17 Lindholm Dep. 101:15-105:10. And it was "[i]n the interest of fairness" to *Oracle* that "Mr.
 18 Lindholm [could not] testify on matters he refused to address in his deposition." ECF No. 676 at
 19 7 (citing *Columbia Pictures Television, Inc. v. Krypton Broadcasting of Birmingham, Inc.*, 259
 20 F.3d 1186, 1196 (9th Cir. 2001)). Now, with infringement portions of the trial out of the way,
 21 Google seeks to introduce the same "explanatory evidence ... that shows the history and context
 22 for that [Lindholm] email" it previously shielded. ECF No. 1555 at 2. But because Google
 23 refused to let Mr. Lindholm answer questions at his deposition (and even objected to related
 24 foundational questions asked by Oracle at the first trial, Tr. 856:10-12), Oracle has had no
 25 opportunity to test Google's current claims about the scope of Mr. Lindholm's investigation.

26
 27 ³ If Google's motion *in limine* is granted, and Google is permitted to rely on FRE evidence, Ora-
 28 cle must be permitted to redisclose its witnesses and hereby reserves the right to do so. Google
 has indicated it will seek to depose these witnesses if they are redisclosed to testify at trial. Ex. B
 (11/25/2015 Kamber Email to L. Simpson).

1 The case law Google cites does not justify exempting the parties' July 2010 settlement
2 negotiations from FRE 408. In *Microban Prods. Co. v. API Indus., Inc.*, 2014 WL 1856471, at *3
3 n.10 (S.D.N.Y. May 8, 2014), an email was deemed admissible over a FRE 408 claim where the
4 defendant sought to exclude it in one sentence, and use it to support an affirmative defense in the
5 next. Here, *Google* asserted privilege over Mr. Lindholm's investigation when such evidence
6 could have been used against *Google* during the infringement phase of the case. And now *Google*
7 is asserting that the investigation related to patents when patent infringement is no longer an
8 issue.

9 *Apple v. Samsung*, 306 F.R.D. 234, 241 (N.D. Cal. 2015), supports Oracle’s position, not
10 Google’s. In that case, Samsung attempted to limit its opponents’ access to privileged material
11 while at the same time making arguments based on the withheld evidence. Samsung waived the
12 privilege when it put privileged documents at issue in its affirmative defenses, and Apple was
13 unfairly disadvantaged because it could not test the basis for Samsung’s claims. *Id.* at 241-42.
14 Here, *Google* asserted privilege over Mr. Lindholm’s testimony and now *Google* seeks to violate
15 FRE 408 to make arguments on the withheld evidence. The only party with limited access to
16 information is *Oracle*, which has never been able to probe Google’s claims about the Lindholm
17 email.

18 In sum, any alleged prejudice to Google from its inability to explain the Lindholm email is
19 the direct result of Google’s decision to assert attorney client privilege and instruct Mr. Lindholm
20 not to answer. It does not justify allowing Google to renege on its agreement, or to violate FRE
21 408. And it is outweighed by the probative value of the email. *See* ECF No. 676 at 2 (holding
22 that probative value of the Lindholm email “outweighs any unfair prejudice” to Google).

Dated: April 29, 2016

Respectfully submitted,

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